

REMARKS/ARGUMENTS

In response to the Office Action mailed August 22, 2007, Applicants amend their application and request reconsideration in view of the amendments and the following remarks. In this amendment, claim 9 is amended, claims 12-24 have been withdrawn, no claims have been cancelled without prejudice and no claims have been added, so that claims 1-24 are currently pending. No new matter has been entered.

Claims 1-24 were subject to a restriction requirement to which applicant's attorney made a provisional election without traverse. Applicants hereby affirm this election without traverse.

Claims 9-11 were rejected under 35 U.S.C. § 112, second paragraph. Applicants have corrected this minor inadvertent error. Accordingly, reconsideration and withdrawal is respectfully requested.

Claims 1-3 and 6-8 were rejected as being unpatentable over US 2005/0033417 to Borges et al. (Borges) in view of US 2003/0065382 to Fischell et al. (Fischell). Claim 4 was rejected as being unpatentable over Borges in view of Fischell and further in view of U.S. Patent No. 6,485,514 to Wrenn. Claims 4 and 5 were rejected as being unpatentable over Borges in view of Fischell and further in view of US 2002/0004679 to Eury et al. These rejections are respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation

of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d,488,20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

None of the references, whether taken alone or in combination discloses the invention of impendent Claim 1. That being said, Applicants specifically submit the following detailed analysis.

"Subject matter developed by another person, which qualifies as prior art under one or more of subsections (e), (f) and (g) of Section 102 of this title, shall not preclude patentability under' this section where the subject matter and the

claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."

We have a 103 rejection wherein the primary reference is a 102 (e) reference. Both the instant application and the references have a common assignee as evidenced by the attached assignments and the inventive entities are different. Accordingly, the Borges reference cannot be used in making a 103 rejection and therefore the entire rejection falls. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Applicant would be grateful for the opportunity to conduct a telephonic or in-person interview if the Examiner believes it would be helpful in disposing of the present case.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

/Carl J. Evens/

By:_____

Carl J. Evens
Reg. No. 33,874

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2518
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